

REMARKS

It is apparent from the Examiner's comments in the Final Rejection of July 22, 2010, that the Examiner has **not** dealt with the claims as amended May 12, 2010, but apparently has proceeded mistakenly as though the claims currently on file were the same claims that were on file prior to the Examiner's Official Action of February 6, 2009. The rejection that the Examiner made in the latest Official Action dated July 22, 2010, in numbered paragraph 3 on page 3 of that Official Action makes it clear that the Examiner is not dealing with the claims currently being sought, which were filed May 12, 2010. In making the rejection of claims 1 through 6, 9-24 and 26 over Section 103(a), on the basis of Henington et al, the Examiner states:

It is noted that Henington et al does not provide more than one conveying member or at least two conveying members located as newly recited.

But claim 1 does not require more than one conveying member.

Claim 1 does not require at least two conveying members.

Rather, claim 1 requires that at least one of the insertion elements carry or secure:

**At least one treatment device or
an ensemble of at least one conveying member and at least one treatment
device.**

This patentable feature is completely absent from the applied art!

It is not understood why the Examiner ignores this absence from Henington et al. As directed by Director Kappos of the USPTO:

Patent quality equals granting those claims the applicant is entitled to under our laws...this means granting broad claims when they present allowable subject matter. (see attachment hereto dated August 25, 2009)

If elements 24 of Henington et al are insertion elements as the Examiner states in line 6 of numbered paragraph 3 of the Official Action of July 22, 2010, then those insertion elements **do not** carry or secure

**At least one treatment device or
an ensemble of at least one conveying member and at least one treatment
device.**

Henington et al's elements 24 carry rollers only; they have absolutely nothing to do with carrying or securing a treatment device, with or without a conveying member.

Henington et al's treatment devices 16 for fluid delivery are clearly not in any respect carried or secured by Henington et al's elements 24.

The treatment devices 16 of Henington et al have no insertion elements to carry or secure them.

Henington et al has no disclosure as to how its treatment devices 16 are mounted in its apparatus.

Henington et al has no disclosure whatever that any treatment device 16 fits into a recess in any carrier element of Henington et al as applicants have claimed, or even that the treatment devices are carried in any respect by carrier elements.

Column 5 lines 15-17 establishes that the machine 10 of Henington et al has a number of fluid delivery apparatus 16. Toward the right end of Fig. 1 of Henington et al, those upper and lower fluid delivery devices [treatment devices] 16 of Henington et al are shown. Note that they are in no respect carried by the apparatus 24 of Henington et al, which the Examiner is treating as being insertion elements.

It is noted that in numbered paragraph 3 of the Official Action, the Examiner relies upon Figs. 7A, 7B and 7C to show insertion elements. Note that nowhere in any of those illustrations, nor in any of the supporting text, is there any relationship between those elements 24 and the treatment devices 16 of Henington et al.

Note that in Fig. 7D of Henington et al, the members 110, 112, carry only the rollers 128, 132; they have nothing whatever to do with carrying or supporting treatment devices 16 of Henington et al.

While it is true as the Examiner states in numbered paragraph 3, that Henington et al teaches an electroplating machine for flat work pieces comprising conveying members 20A and 20B, that statement has nothing whatever to do with the features that have been repeatedly argued as being absent from Henington et al and which are required by the claims; namely that at least one of the insertion elements carry or secure either at least one treatment device or an ensemble of at least one conveying member and at least one treatment device.

It is noted that at the top of page 4 of the Official Action of July 22, 2010, the Examiner states that Applicants have not established the criticality of the need for a plurality of conveying

members, and that the Examiner interprets this as a matter of duplication of parts, citing certain legal authority, and then concludes that a mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

Those statements are completely irrelevant to the claims presently being sought. Claim 1, for example **nowhere** requires a plurality of conveying members. Those statements at the top of page 4 were taken from numbered paragraph 5 of the Official Action of February 6, 2009, which dealt with different claims, **not** the claims that the Examiner is supposed to have addressed in the current Official Action, which are the claims that were placed on file May 12, 2010.

Again, at the top of page 4 of the Official Action of July 22, 2010, the Examiner states that it would have been obvious for one of ordinary skill in the art to duplicate the conveying members of Henington et al in order to increase the throughput. That statement of the Examiner also has nothing to do with the claims being sought herein, as are addressed above. That is, the claims that are being addressed herein do not require duplicating conveying members, and even if they did, such **in no way** would that have any effect on throughput. Throughput is determined by the speed of the drive shaft 25 of Figs. 4 and 5 of the present application, which drives all of the rollers. Thus, whether that drive shaft would drive one conveying member or one hundred conveying members would have no effect whatever on increasing the throughput. As a matter of basic mechanics, the throughput of PCBs would be the same irrespective of the number of conveying members.

With respect to the other independent claims of this application; namely claims 23 and 24, these claims, like claim 1, likewise require that at least one of the insertion elements carries or secures at least one treatment device or an ensemble of at least one conveying member and at least one treatment device, and likewise are not rejectable over Henington et al.

Claim 26 is even more limited, in that it does not require that the insertion element carry or secure any conveying member. Rather, it requires that the at least one insertion element carry or secure at least one treatment device. Clearly, in Henington et al that which the Examiner regards as an insertion element; namely the element 24, **in no respect** carries a treatment device.

Certain of the dependent claims have been rejected over Henington et al in view of either Pender or Haas et al. Nothing whatever in Pender or Haas et al addresses the deficiencies of Henington et al that are described above, in that those secondary references have nothing to do with an insertion element carrying or securing at least one treatment device or an ensemble of at least one

conveying member and at least one treatment device.

In numbered paragraph 1 of the Official Action of July 22, 2010, the Examiner apparently disregards the sworn Declaration of Mr. Hauf as not being “related to the claimed invention”.

The Declaration of Mr. Hauf establishes his expertise in numbered paragraphs 2 through 4. Additionally, numbered paragraph 5 establishes that he is in fact talking about the claims of the instant application.

Paragraphs 6 and 7 of the Declaration specifically address the very deficiencies of Henington et al that are present in the claims currently being sought of record; namely that the claims require a module system that includes a treatment device and how Henington et al is deficient in that respect. It is noted that the Examiner has stated that “...the attorney’s arguments cannot take the place of evidence”. But a sworn affidavit is evidence; not attorney’s argument. Moreover, Attorney’s argument can point out where in the prior art the prior art is physically incapable of meeting the subject matter of the claims, as the Attorney has done in this case. However, the evidence that is present in the sworn statement of Mr. Hauf goes on at length, in numbered paragraphs 6 through 13 to address the structure that is present in the claims that are currently being sought and the deficiencies of Henington et al with respect to that structure. It would seem that the Examiner has not appreciated that the sworn declarant Hauf is specifically addressing the claims presently being sought, in numbered paragraphs 5 and 6, and in subsequent paragraphs specifically deals with the very deficiencies of Henington et al that are argued herein.

Starting at the bottom of page 2 of the Official Action, the Examiner correctly notes that there must be a nexus between the commercial success and the claimed invention. But that is exactly what the Declaration of Mr. Hauf provides, starting with paragraphs 5 and 6, and continuing through paragraphs 11 through 16. In paragraphs 5 and 6, Mr. Hauf specifically addresses the invention as claimed.

In paragraph 15 of the Declaration, the favorable feedback from customers is addressed with respect to the features of this invention that are set forth in the claims, and such is of probative value, because the positive commercial reception by the trade is a secondary indicia of patentability.

Additionally, it is noted that the Examiner has missed several important points of the Declaration of Mr. Hauf, in stating that “...it was noted that no evidence concerning what the treatment devices comprise” (p. 3 L 4-5). Again, in paragraphs 5 and 6 of Mr. Hauf’s Declaration, he is talking about the claims of the instant application, and he continues in paragraph 7 to state:

All of the claims of the present patent application require a treatment unit comprising at least one module system that includes a treatment device (with or without at least one conveying member) and that comprises an insertion element fitted into recesses (21) of carrier elements (4, 5).

Henington et al has treatment devices 16, but (A) these treatment devices have no insertion elements that carry or secure them, and (B) Henington et al has no disclosure how these treatment devices are mounted in the apparatus, and (C) Henington et al has not disclosure that any treatment device 16 fits into any recess in the carrier elements of Henington et al.

Thus, the Declaration definitely provides evidence as to treatment devices that were the subject of the commercial success; namely, those that correspond to the current claims.

The Examiner has also stated that no comparisons with sales of other devices were discussed. Not so. Paragraphs 14-16 of the Hauf Declaration and the chart of Evidence Exhibit B show that there was a treatment device of one type sold up through 2004, before the current invention was introduced into the equipment, and that thereafter, when the current invention as set forth in the claims was introduced into the equipment, there was a substantial increase in sales, 90 percent of which included the invention. The comparison was thus between equipment sales of the Assignee before introduction of the invention and equipment sales after the introduction of the invention. Thus, such a comparison is provided, and the chart indicates prior sales figures, so that the Examiner's statement that "no indications of prior sales or figures were included", is not supported by the facts. The sworn Declaration is evidence of prior sales figures.

It is noted that the Examiner has stated that no indications of choices available to customers were discussed. However, such is not a requirement for evidence of commercial success. Commercial success can take many forms. In some cases there will be evidence of choices available to customers and in other cases there will not be such evidence. Here, there is evidence directly related to the claimed features that are absent from Henington et al, which, when introduced into equipment of the Assignee resulted in substantial commercial success, as the Declaration and chart of Mr. Hauf provide.

Reconsideration is respectfully requested, and especially consideration of the claimed features that are addressed herein as being completely absent from Henington et al in accordance

with the claims that were submitted May 12, 2010, and allowance of the application with all of its claims is respectfully solicited.